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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,600	10/04/2001	William H. Wisecarver III	1480-00	1951

35811 7590 09/21/2006

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP  
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EXAMINER
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ALPERT, JAMES M

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/970,600

Applicant(s)

WISECARVER ET AL.

Examiner

James Alpert

Art Unit

3693

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 30 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☒ Other: See Continuation Sheet.

SUPERVISOR  
TECHNICAL

Continuation of 13. Other:

The Examiner appreciates the Applicants' submission of a statement under 37 CFR 116(e). Applicants' arguments have been fully considered, but they are not persuasive. The Examiner maintains that there is not a sufficient showing of good cause as to why the Affidavit received on 06/26/2006 (after final) was not presented earlier. Further, determining prior invention after final would require additional search and consideration.

In the submitted 1.116(e) statement, Applicants suggest that a "revised" affidavit was submitted to accommodate the Examiner's objections to the first filed affidavit. To the contrary, the Examiner did not request any accommodation. Rather, the Examiner pointed out that the first filed affidavit (received 10/21/2005) was insufficient under the rules and requirements laid out in various sections of the Manual of Patent Examining Procedure (MPEP). The Examiner has NEVER indicated that any affidavit, original, new, revised or otherwise, would place the application in condition for allowance. At this point, the examiner has concluded that the first filed affidavit is insufficient, and that the second filed affidavit was filed after final. The question has become whether there is good cause for the filing of the second affidavit after final.

Applicant essentially argue that the reason for the filing of the affidavit after final was because they believed in good faith that the first filed affidavit was sufficient. This may be the case, but knowledge of the rules and requirements of the MPEP are imputed to Applicants and their representatives. The requirements for sufficiency of affidavits as laid out in the MPEP are quite clear, while the insufficiencies of the first filed affidavit are quite glaring. The examiner does not find this argument convincing.

The examiner further observes that substantive statements in the two affidavits change the nature of the affidavits entirely. In the first filed affidavit, Applicants appear to argue that their invention was reduced to practice prior to the effective date of the Armes reference, U.S. Patent Application Publication #20010034720. The examiner assumes this to be the case because the submitted exhibit is said to be authored prior to the effective date of Armes, presumably to show prior reduction to practice. In addition, no mention is made of diligence whatsoever. In the second filed affidavit, Applicants expressly state that the invention was conceived prior to the effective date of Armes, but reduced to practice later. The standards for sufficiency of the affidavits and exhibits in these two situations are completely different. Applicants have not shown any good cause as to why the second filed affidavit, alleging prior conception coupled with later diligence, was not filed in the first instance. At this time, determining whether prior conception and diligence have been adequately proven would require substantial additional consideration as to whether conception and diligence have been shown.

Applicants' request for entry of the affidavit filed after final, and corresponding request for allowance are respectfully declined.